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on March 3, 2003

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Jonathan P. Taylor, Ph.D., Reg. No. 48,338

Name of applicant, assignee or
Registered Representative

Jonathan P. Taylor
Signature

3/3/03
Date of Signature

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Our Case No. 659/766

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Gary L. Shanklin

Serial No. 09/753,134

Filing Date: December 29, 2000

For ANTIMICROBIAL ABSORBENT
ARTICLE, AND METHODS OF
MAKING AND USING THE SAME

Examiner Lynda Salvatore

Group Art Unit No. 1771

REQUEST FOR RECONSIDERATION

Commissioner for Patents
Box Non-Fee Amendment
Washington, D.C. 20231

Dear Sir:

This communication is in response to the Office Action mailed on October 4, 2002. Applicants respectfully request that the Examiner reconsider the rejections in view of the following remarks, as set forth below:

ELECTION

The Examiner has required restriction between Group I, claims 1-22, and Group II, claims 23-34. Applicants hereby acknowledge the election of Group I, claims 1-22.

REMARKS

The present invention includes a multi-ply absorbent article having an outer ply and an inner ply. The outer ply contains a siloxane composition, and the inner ply contains an antimicrobial agent. Embodiments of the invention include multi-ply absorbent articles that are soft and non-irritating, yet capable of killing microorganisms. Embodiments of the invention also include multi-ply absorbent articles capable of entrapping fluids so as to prevent exposure of the user to the fluid and to kill microorganisms present in the fluid. Claims 1-22 are pending and have been rejected under 35 U.S.C. § 103. The rejection of the claims under 35 U.S.C. § 103 is respectfully traversed.

Claims 1-3 and 5-22 were rejected under 35 U.S.C. § 103(a) over Rothe et al. (U.S. Pat. No. 4,738,847) in view of Goulet et al. (WO 99/37860). The Office Action asserts that Rothe et al. teaches a multi-ply absorbent article containing a virucidal composition in an inner layer, and that Goulet et al. teaches a multi-ply absorbent article containing an amine-modified polysiloxane in an outer layer. The Office Action recognizes that neither Rothe et al. nor Goulet et al. individually disclose a multi-ply absorbent article having an outer ply containing a siloxane composition in combination with an inner ply containing an antimicrobial agent.

Applicants respectfully point out that the Examiner has not established a *prima facie* case of obviousness under 35 U.S.C. § 103. As noted in MPEP 2142, with reference to *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985):

The initial burden is on the examiner to provide some suggestion of the **desirability** of doing what the inventor has done. [Emphasis added]

Further, it is noted in the MPEP 2143.01, with reference to *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993):

A statement that modifications of the prior art to meet the claimed invention would have been “well within the ordinary skill of the art at the time the claimed invention was made” because the references relied upon teach that all aspects of the claimed invention were individually known in the art is **not sufficient** to establish a *prima facie* case of obviousness without some **objective reason to combine** the teachings of the references. [Bold emphasis added]

It has further been established that the motivation to combine the teachings of the references may not be extracted from Applicants' description of the advantages of or the problems solved by the claimed invention. For example, in the decision of *In re Rouffet*, 47 USPQ2d 1453 (Fed. Cir. 1998), the court stated:

...the examiner **must show reasons** that the skilled artisan, confronted with the same problems as the inventor and **with no knowledge of the claimed invention**, would select the elements from the cited prior art references for combination in the manner claimed. [Emphasis added]

The statement in the Office Action that one “having ordinary skill in the art” would be motivated to make a soft and hydrophobic absorbent article with virucidal characteristics is thus insufficient to establish a *prima facie* case of obviousness. This statement is not based on any teaching or suggestion in the references to make Applicants' invention, but rather is based on the properties of the individual inventions as disclosed in the references. Moreover, no evidence is provided of the motivation understood by those skilled in the art, for example in the form of a reference or an affidavit by the Examiner. Thus, until the Examiner provides appropriate references or affidavits showing evidence of a motivation to combine the teachings of Rothe et al. and Goulet et al., a *prima facie* case of obviousness has not been presented.

Claims 1-8, 13, 14, 18, 19 and 20-22 were rejected under 35 U.S.C. § 103(a) over Rothe et al. in view of Roe et al. (U.S. Pat. No. 5,635,191). The Office Action asserts that Roe et al. teaches a disposable diaper having a top sheet containing a polysiloxane as part of an emollient composition, an inner sheet formed by an absorbent core, and a liquid impervious back sheet. Rothe et al. is applied as in the rejection of claims 1-3 and 5-22. The Office Action recognizes that neither Rothe et al. nor Goulet et al. individually disclose a multi-ply absorbent article having an outer ply containing a siloxane composition in combination with an inner ply containing an antimicrobial agent.


Applicants respectfully point out that the Examiner has not established a *prima facie* case of obviousness under 35 U.S.C. § 103, for at least the reasons set forth above. The statement in the Office Action that one "having ordinary skill in the art" would be motivated to make a disposable personal care article with virucidal characteristics is thus insufficient to establish a *prima facie* case of obviousness. This statement is not based on any teaching or suggestion in the references to make Applicants' invention, and no evidence is provided of the motivation understood by those skilled in the art. Thus, until the Examiner provides appropriate references or affidavits showing evidence of a motivation to combine the teachings of Rothe et al. and Roe et al., a *prima facie* case of obviousness has not been presented.

In conclusion, all of the grounds raised in the outstanding Office Action for rejecting the application are believed to be overcome or rendered moot based on the remarks above. Thus, it is respectfully submitted that all of the presently presented claims are in form for allowance, and such action is requested in due course. Should the Examiner feel a discussion would expedite the prosecution of this application, the Examiner is kindly invited to contact the undersigned.

Also submitted at this time is a Petition for Extension of Time for two (2) months.

Respectfully submitted,

3/3/03


Jonathan P. Taylor, Ph.D.
Registration No. 48,338
Agent for Applicant

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1771 \$

TRANSMITTAL LETTER			Case No. 659/766
Serial No. 09/753,134	Filing Date December 29, 2000	Examiner Lynda Salvatore	Group Art Unit 1771
Inventor(s) Gary L. Shanklin			
Title of Invention Antimicrobial Absorbent Article, and Methods of Making and Using the Same			

TO THE COMMISSIONER FOR PATENTS

Transmitted herewith is Request for Reconsideration and return postcard.

- ☐ Small entity status of this application under 37 CFR § 1.27 has been established by verified statement previously submitted.
- ☐ Applicant claims small entity status. See 37 CFR 1.27.
- ☒ Petition for a two month extension of time.
- ☐ No additional fee is required.
- ☐ The fee has been calculated as shown below:

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	Claims Remaining After Amendment		Highest No. Previously Paid For	Present Extra
Total		Minus		
Indep.		Minus		
First Presentation of Multiple Dep. Claim				

Small Entity	
Rate	Add'l Fee
x \$9 =	
x 42 =	
+ \$140 =	
Total add'l fee	\$

Other Than Small Entity	
Rate	Add'l Fee
x \$18 =	
x \$84 =	
+ \$280 =	
Total add'l fee	\$

- ☐ Please charge Deposit Account No. 23-1925 (BRINKS HOFER GILSON & LIONE) in the amount of \$____. A duplicate copy of this sheet is enclosed.
- ☒ A check in the amount of \$410 to cover the filing fee is enclosed.
- ☒ The Commissioner is hereby authorized to charge payment of any additional filing fees required under 37 CFR § 1.16 and any patent application processing fees under 37 CFR § 1.17 associated with this communication or credit any overpayment to Deposit Account No. 23-1925. A duplicate copy of this sheet is enclosed.
- ☒ I hereby petition under 37 CFR § 1.136(a) for any extension of time required to ensure that this paper is timely filed. Please charge any associated fees which have not otherwise been paid to Deposit Account No. 23-1925. A duplicate copy of this sheet is enclosed.

Respectfully submitted,


Jonathan P. Taylor, Ph.D.
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Agent for Applicant

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